

**REMARKS:**

Claims 1-41 remain in the application for consideration of the Examiner.

Reconsideration and withdrawal of the outstanding rejections is respectfully requested in light of the above amendments and following remarks.

Claim 1 has been objected to because of an informality. It is respectfully submitted that appropriate correction has been made to claim 1 by this Amendment. Reconsideration and withdrawal of the objection to claim 1 is therefore respectfully requested.

**REJECTION UNDER 35 U.S.C. § 103(a):**

Turning now to the art rejection, claims 1-41 stand rejected under 35 U.S.C. § 103(a) over Kennedy et al. (WO 00/17795) in view of Asthana et al. (U.S. Patent No. 5,265,006).

This rejection is respectfully traversed.

It is noted that the Office Action, at page 5, second paragraph, states:

[I]t has been held that the recitation that an element is 'operable to' perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense.

However, Applicant respectfully disagrees with this statement. Applicant is unaware of any such holding and therefore requests citation of an appropriate authority or that this statement be withdrawn. On the other hand, it is respectfully pointed out that a recent search of a patent database revealed that the U.S. Patent Office has issued over 130,000 patents that include the phrase "operable to" recited at least once in the claims.

Kennedy et al. does not disclose or suggest a local database for storing consolidated product availability information.

It follows that Kennedy et al. also does not disclose or suggest enabling a component quotation to be generated without retrieving product availability information from ATP servers in response to a component ATP request.

The Office Action acknowledges these shortcomings in the disclosure of Kennedy et al., but alleges that Asthana et al. discloses these concepts. However, this allegation is respectfully traversed.

In fact, Asthana et al. teaches away from these concepts of consolidating information in a local database and independently generating component quotations. For example, see Asthana et al., col. 2, lines 20-34 and col. 2, line 59 – col. 3, line 4, which teaches a system where key decisions are made at a global level, and associated parameters are passed to the local level. This teaching directly contradicts the concept of consolidating decision making capabilities to a local level.

It is also noted that Asthana et al. also fails to teach enabling a component quotation to be generated without retrieving product availability information from ATP servers in response to a component ATP request.

In light of the shortcomings of these references, the proposed combination of these references would clearly fail to disclose or suggest all of the limitations of claims 1, 22, 39, 40, and 41, as well as the claims 2-21 which depend from claim 1 and claims 23-38 which depend from claim 22.

It is respectfully pointed out that the Office Action provides no explanation regarding the new rejections of claims 6-21 and 27-38 and how the limitations thereof are considered obvious. If the rejections thereof are maintained, then clarification is respectfully requested. Otherwise, it is respectfully requested that the rejection of these claims be reconsidered and withdrawn.

In light of the above, it is respectfully submitted that claims 1-41 are in condition for allowance, and notice to that effect is respectfully requested.

### **The Legal Standard for Obviousness Rejections Under 35 U.S.C. § 103:**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's

disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991; *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

**CONCLUSION:**

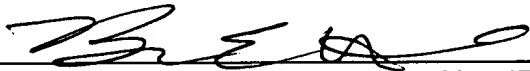
In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

A Request for Continued Examination is submitted herewith that includes an authorization for charging the \$790.00 RCE fee to **Deposit Account No. 500777**. The undersigned hereby authorizes the Director to charge any additional fees that may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing the Amendment and RCE to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

9 JUNE 2005  
Date

  
James E. Walton, Registration No. 47,245  
Daren C. Davis, Registration No. 38,425  
Brian E. Harris, Registration No. 48,383  
Michael Alford, Registration No. 48,707  
Law Offices of James E. Walton, P.L.L.C.  
1169 N. Burleson Blvd., Suite 107-328  
Burleson, Texas 76028  
(817) 447-9955 (voice)  
(817) 447-9954 (facsimile)  
jim@waltonpllc.com (e-mail)

**CUSTOMER NO. 53184**  
**ATTORNEYS AND AGENTS FOR APPLICANT**